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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/671,739	09/29/2000	Scott A. Moskowitz	031838.0006	2060

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WILEY, REIN & FIELDING, LLP
ATTN: PATENT ADMINISTRATION
1776 K. STREET N.W.
WASHINGTON, DC 20006

EXAMINER

LEROUX, ETIENNE PIERRE

ART UNIT	PAPER NUMBER
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2171

DATE MAILED: 05/23/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/671,739

Applicant(s)

MOSKOWITZ ET AL.

Examiner

Etienne P LeRoux

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-61 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-61 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 49 and 50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 49 recites “determining invariant characteristics for the reference signal; selecting the invariant characteristics that have a minimum variation.” The language term “invariant characteristic” and the term “invariant characteristics that have a minimum variation” is a relative term which renders the claim indefinite. The specification does not provide a standard for ascertaining for determining which invariant characteristic has a minimum variation. Examiner maintains that an invariant signal which has a minimum variation is a contradiction. Claim 50, includes similar language.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 3, 7-10, 12-40, 51-53 and 55-61 are rejected under 35 U.S.C. 102(e) as being anticipated by US Pat. No. 6,230,268 issued to Miwa et al (hereafter Pat '268).

Regarding claim 1, Pat '268 discloses:

a first input that receives at least one reference signal to be monitored [Fig 6, owner digital content]

a first processor that creates an abstract of each reference signal input to said first processor through said first input [Fig 6, owner abstract]

a second input that receives at least one query signal to be analyzed [Fig 6, user digital content]

a second processor that creates an abstract of each query signal [Fig 6, user abstract]

a reference database that stores abstracts of each at least one reference signal [Fig 6, inherent]

a comparing device that compares an abstract of said at least one query signal to the abstracts stored in the reference database to determine if the abstract of said at least one query signal matches any of the stored abstracts [Fig 6, compare]

a device that permits submission of reference signal abstracts to the reference database [Fig 6, inherent]

Regarding claim 1, examiner maintains that in the referenced patent, Pat '268, that

“a reference database that stores abstracts of each at least one reference signal” and

“a device that permits submission of reference signal abstracts to the reference database” is

inherent. Examiner notes, the MPEP § 2112.01 states “[w]here the claimed and prior art

products are identical or substantially identical in structure or composition, or are produced by

identical or substantially identical processes, a *prima facie* case of either anticipation or

obviousness has been established. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA

1977). ‘When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not.’ *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).”

Regarding claim 3, Pat ‘268 discloses the reference database is available to the public [col 8, lines 15-18].

Regarding claim 7, Pat ‘268 discloses value-adding components [col 8, line 30].

Regarding claim 8, Pat ‘268 discloses the second input is remotely coupled to the system [Fig 6].

Regarding claim 9, Pat ‘268 discloses the second processor is remotely coupled to the system [Fig 6].

Regarding claim 10, Pat ‘268 discloses the system transmits criteria that as being used by the first processor to the second processor [Fig 6]

Regarding claims 12, 26 and 33, Pat ‘268 discloses a certification authority [col 6, lines 19-36].

Regarding claims 13, 32 and 58, Pat ‘268 discloses:

a first input that receives at least one reference signal to be monitored [Fig 6, owner digital content]

a first processor that creates an abstract of each reference signal input to said first processor through said first input [Fig 6, owner abstract]

a second input that receives at least one query signal to be analyzed [Fig 6, user digital content]

a second processor that creates an abstract of each query signal [Fig 6, user abstract]

a reference database that stores abstracts of each at least one reference signal [Fig 6, inherent]

a comparing device that compares an abstract of said at least one query signal to the abstracts stored in the reference database to determine if the abstract of said at least one query signal matches any of the stored abstracts [Fig 6, compare]
means for linking/embedding the query signal abstract to the reference signal corresponding to the matching reference signal abstract [Fig 6, matching]

Regarding claim 14, Pat '268 discloses the linking is dependent on predetermined access rules [col 8, lines 15-20]

Regarding claim 15, Pat '268 discloses signal quality [col 3, lines 1-5].

Regarding claim 16, Pat '268 discloses a set of related abstracts for substantially the same signal [col 7, lines 24-33]

Regarding claim 17, Pat '268 discloses the abstract is distributed to a plurality of locations [col 1, lines 14-30]

Regarding claim 18, Pat '268 discloses means for linking the query signal abstract to the reference signal is bi-directional [Fig 6, compare and col 8, lines 14-18]

Regarding claim 19, Pat '268 discloses electronic linking [col 1, lines 4-11]

Regarding claim 20, Pat '268 discloses access control [col 4, lines 36-39]

Regarding claim 21, Pat '268 discloses a public network [col 1, lines 14-22]

Regarding claim 22, Pat '268 discloses a means to monitor the comparison difference [Fig 6, match?]

Regarding claims 27 and 59, Pat '268 discloses embedding each reference signal with its corresponding reference signal [col 2, lines 1-15]

Regarding claims 28, 31, 35, 36 and 55, Pat '268 discloses the signal is hashed before it is embedded [Fig 5]

Regarding claims 29, 38 and 56, Pat '268 discloses the reference signal is digitally signed before it is embedded [Fig 5]

Regarding claim 30, Pat '268 discloses the matching signal abstract is downloadable [col 7, lines 34-41]

Regarding claims 34 and 39, Pat '268 discloses the abstract is embedded with a predetermined key [Fig 7]

Regarding claim 37 and 40, Pat '268 discloses the abstract is associated with a key [Fig 7]

Regarding claims 51-53, Pat '268 discloses a device for attaching the corresponding reference signal abstract to each reference signal [col 2, lines 1-5].

Regarding claims 57 and 60 and 61, Pat '268 discloses determining an authorized signal [Fig 6, compare]

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 4 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 6,230,268 issued to Miwa et al (hereafter Pat '268) as applied to claim 1 above.

Regarding claim 4, Pat '268 discloses the essential elements of the claimed invention except for access to the database is limited to at least one of specific members of the public and specific companies. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Pat '268 to include the database is limited to at least one of specific members of the public and specific companies for the purpose of marketing a service and therefore, requiring users to pay for the service provided.

Regarding claim 11, Pat '268 discloses the claimed invention except for creating and storing new abstracts. It would have been obvious at the time the invention was made to modify Pat '268 to include creating and storing new abstracts, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

5. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 6,230,268 issued to Miwa et al (hereafter Pat '268) as applied to claim 1 above, and further in view of US Pat No. 6,199,058 issued to Wong et al (hereafter Pat '058).

Regarding claim 2, Pat '268 discloses suitable content members (Fig 6, owner content) but does not disclose a database report. Pat '058 discloses a database report (claim 13). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Pat '268 to include a database report as taught by Pat '058 for the purpose of providing to a user the current status of the database.

6. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 6,230,268 issued to Miwa et al (hereafter Pat '268) as applied to claim 1 above, and further in view of US 2002/0026343 issued to Duenke (hereafter Pat '343).

Regarding claim 5, Pat '268 discloses the essential elements of the claimed invention except for a report to determine database pricing. Pat '343 discloses a report to determine database pricing [paragraph 43]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Pat '268 to include report to determine database pricing as taught by Pat '343 for the purpose of estimating construction costs [abstract].

Regarding claim 6, Pat '268 discloses the essential elements of the claimed invention except for the report is used to determine suitable content for a searchable index of content. Pat '343 discloses the report is used to determine suitable content for a searchable index of content. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Pat '268 to include the report is used to determine suitable content for a searchable index of content as taught by Pat '343 for the purpose of overcoming learning difficulties [paragraph 42].

7. Claim 23 is are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 6,230,268 issued to Miwa et al (hereafter Pat '268) as applied to claim 22 above, and further in view of US Pat No. 6,381,618 issued to Jones et al (hereafter Pat '618).

Regarding claim 23, Pat '268 discloses the essential elements of the claimed invention except for the comparison device is part of a web browser. Pat '618 discloses the comparison device is part of a web browser [col 5, lines 30-37]. It would have been obvious to one of

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ordinary skill in the art at the time the invention was made to modify Pat '268 to include the comparison device is art of a web browser as disclosed by Pat '618 for the purpose of determining whether the retrieved copy is a copy of a most recent version of the first document [abstract].

Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 6,230,268 issued to Miwa et al (hereafter Pat '268) as applied to claim 22 above, and further in view of US Pat No. 5,884,033 issued to Duvall et al (hereafter Pat '033).

Regarding claim 24, Pat '268 discloses the essential elements of the claimed invention except for the comparison device is part of a filtering function. Pat '033 discloses the comparison device is part of a filtering function [Fig 4]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Pat 268 to include the comparison device is part of a filtering function as taught by Pat '033 for the purpose of deciding whether to block or allow incoming and/or outgoing transmissions of messages [abstract].

8. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 6,230,268 issued to Miwa et al (hereafter Pat '268) as applied to claim 23 above, in view of US Pat No. 6,381,618 issued to Jones et al (hereafter Pat '618) and further in view of US Pat No. 5,478,990 issued to Montanari et al (hereafter Pat '990).

Regarding claim 25, the combination of Pat 268 and Pat '618 discloses the essential elements of the claimed invention except for a means for non-owners of the reference database to submit signals to the reference database. Pat '990 discloses a means for non-owners of the

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reference database to submit signals to the reference database [col 11, lines 53-61]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Pat '268 and Pat '618 to include a means for non-owners of the reference database to submit signals to the reference database as taught by Pat '990 for the purpose of maintaining the database current and up-to-date.

9. Claims 41 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 6,230,268 issued to Miwa et al (hereafter Pat '268) in view of US Pat No. 6,457,058 issued to Ullum et al (hereafter Ullum '058).

Regarding claims 41 and 54, Pat '268 discloses the essential elements of the claimed invention except for a digital signal having a known distribution address. Ullum '058 discloses a digital signal having a known distribution address [abstract]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Pat '268 to include a digital signal having a known distribution address as taught by Ullum '058 for the purpose of improving RAM access [abstract]

10. Claims 42-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of US Pat. No. 6,230,268 issued to Miwa et al (hereafter Pat '268) and US Pat No. 6,457,058 issued to Ullum et al (hereafter Ullum '058) and further in view of US Pat. No. 5,920,900 issued to Poole et al (hereafter (Pat '900).

Regarding claims 42 and 43, the combination of Pat '268 and Pat '058 discloses the essential elements of the claimed invention except for distribution of the digital signal when the

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digital signal abstract does not match an abstract in the database. Pat '900 discloses distribution of the digital signal when the digital signal abstract does not match an abstract in the database [col 3, lines 23-25]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Pat '268 and Pat '058 to include distribution of the digital signal when the digital signal abstract does not match an abstract in the database as taught by Pat '900 for the purpose of providing an efficient and low cost method of translation [col 3, lines 1-5].

Regarding claims 44 and 45, the combination of Pat '268 and Pat '058 discloses the essential elements of the claimed invention except for distribution of the digital signal when the digital signal abstract does match an abstract in the database. Pat '900 discloses distribution of the digital signal when the digital signal abstract does match an abstract in the database [col 3, lines 20-22]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Pat '268 and Pat '058 to include distribution of the digital signal when the digital signal abstract does match an abstract in the database as taught by Pat '900 for the purpose of providing an efficient and low cost method of translation [col 3, lines 1-5].

Regarding claim 46, examiner maintains "wherein the database is created by at least one of a music company, a movie studio, an image archive, and a combination thereof" is drawn to intended use and is not given patentable weight.

Regarding claim 47, Pat '268 discloses at least one of digital images, digital audio and digital video [col 1, lines 15-20].

Regarding claim 48, Pat '268 discloses copyright status [col 1, lines 14-16].

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Etienne (Steve) LeRoux whose telephone number is (703) 305-0620.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached at (703) 308-1436.

Any inquiry of a general nature relating to the status of this application or processing procedure should be directed to the receptionist whose telephone number is (703) 305-3900.

Etienne LeRoux

5/19/03



SAFET METJAHIC
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100